

REMARKS

Claims 1, 2, 5-10, 13 and 14 are pending in this application. By this Amendment, claim 1 is amended. No new matter is added.

I. Information Disclosure Statement

Applicants respectfully request acknowledgement of receipt and consideration of the references submitted in the December 7, 2005, Information Disclosure Statement.

II. Claim Rejections Under 35 U.S.C. §103

Claims 1, 2, 5-10, 13 and 14 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,586,982 to Abela in view of the European Journal of Physiology, Vol. 433, pages 832-841 by Henriksen and further in view of U.S. Patent No. 3,573,456 to Beeh, and further in view of U.S. Patent No. 5,498,260 to Rink and further in view of Optics Letters, Vol. 23, pages 1226-1228, by Matsura. The rejection is respectfully traversed.

None of the applied references, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims, as amended. For example, the combination of references fails to disclose or suggest a method for processing a cell, comprising: irradiating a living cell or a living tissue with a laser beam with 1-100 m/cm² of the energy density and 1-1000 mJ/cm² of the energy output through a hollow optical fiber filled with an inert gas; and cutting off, removing or boring a cell wall or a cell membrane or an entirety of the cell wall thus irradiated; wherein the cell is irradiated with the laser through reflection and condensing which are effected through a chip of quartz glass in which hydroxide groups have been introduced, as recited in amended claim 1.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference. Second, there must be reasonable expectation of success. Finally, the prior art

references must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Applicants' disclosure (see MPEP §706.01(j)).

Applicants submit that there is no suggestion or teaching in any of the applied references to make the combination as proposed in the Office Action. Rather, the Office Action relies on Applicants' disclosure to base the motivation for such a combination of references. In this case, the combination of references addresses such disparate problems as to be completely unrelated to one another.

35 U.S.C. §103 requires some motivation or suggestion, before the invention itself to make the new combination. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). The use of a reference in an obviousness rejection may be supported if the references' disclosure relates to the same problem as the claimed invention. *In re Clay*, 956 F.2d, 656, 659 (Fed. Cir. 1992). As not all of the applied references are addressing a problem similar to that of this invention, there can be no suggestion in the references to make such a combination. For example, Beeh is addressing problems in fundamental limitations of direct contact printing approaches when there is no direct contact between the image and silicone. These problems cause difficulties in high volume printing of silicon wafers. (See col. 1 of Beeh).

Additionally, in making an assessment of the differences between the prior art and the claimed subject matter, 35 U.S.C. §103 specifically requires consideration of the claimed invention as a whole. The "as a whole" instruction in 35 U.S.C. §103 prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might break an invention into its component parts, then find its prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a road map to find a prior art components. *Ruiz v. A. B. Chance Co.*, 357 F.3d 1270, 1275, (Fed. Cir. 2004).

In the examination of this case, the claimed subject matter has not been considered as a whole. Rather, the subject matter in this invention has been evaluated on a part-by-part basis as is evidenced by the combination of five references in different art areas in an effort to provide support for each and every feature recited in the rejected claims. Accordingly, it is clear that hindsight has been used in making the obviousness determination in this case when rejecting the claims as obvious.

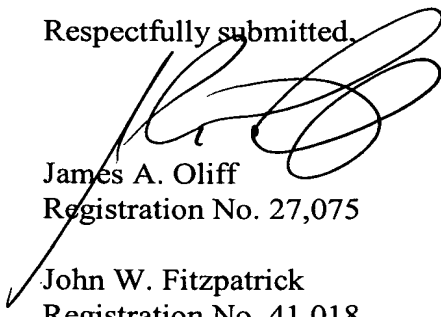
Finally, even were such an improper combination of references made, the combination of references still fails to disclose or suggest each and every feature recited in the rejected claims as amended. As none of the applied references disclose or suggest irradiating a cell with a laser through reflection and condensing that are affected through a chip of quartz in which hydroxide groups have been introduced, the combination of references fails to disclose or suggest each and every feature recited in the rejected claims. Furthermore, none of the applied references disclose or suggest the additional feature of irradiating a living cell or a living tissue with a laser beam with $1-100 \text{ m/cm}^2$ of the energy density and $1-1000 \text{ mJ/cm}^2$ of the energy output through a hollow optical fiber filled with an inert gas. Accordingly, withdrawal of the rejection of claims 1, 2, 5-10, 13 and 14 under 35 U.S.C. §103(a) is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 5-10, 13 and 14 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Request for Continued Examination
Petition for Extension of Time

JAO:JWF/ldg

Date: January 5, 2006

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